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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,114	03/02/2004	Yasuhiro Urata	249501US90	1146
22850 7590 07/16/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER ZENATI, AMAL S				
ART UNIT 2614		PAPER NUMBER		
NOTIFICATION DATE 07/16/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/790,114

**Applicant(s)**

URATA ET AL.

**Examiner**

AMAL ZENATI

**Art Unit**

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02/06/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 07/07/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 1 recites the limitation “and including” in line 4. The subject of the phrase is unclear, is it referring to the “receiver” in line 2, or “a predetermined tone” in line 3? Moreover, claim 1 recites the limitation “the tone information” in line 15. It is unclear whether the “the tone information” is referring to either “selecting tone information” in line 8, “tone information” in line 9 or “selected tone information” in line 12. Furthermore, claim 1 recites the limitation “the information communication terminal” in line 19. There is insufficient antecedent basis for this limitation in the claim. Applicant should resolve this ambiguity and follow the corresponding correction to claim 5.

#### *Claim Rejections - 35 USC § 102*

4. The following is appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1**, are rejected under 35 U.S.C 102 (e) as being anticipated by **Olschwang (provisional application No. 60/452526)**

Consider **claim 1 and 5 Olschwang** clearly shows and discloses the Fun-Dial customized ring back tone solution (a tone information providing system) comprising when A (calling-terminal) calls B (called-terminal), SSP (receiving means) receives a call (calling information) from A (calling-terminal); SSP sends an IN message to the Fun-dial SCP, based on the called party B number; The SCP indicates that A and B numbers (tone information including called-terminal specifying information for specifying the communication terminal and called-terminal specifying information for specifying a communication terminal for a calling destination); The Content Delivery Platform VoiCD at this point will identify the subscriber B and the caller A (tone information selecting means) that has been stored (tone information storing means) then the Content Delivery Platform will transmit (transmitting means) the content tone to A. (Page 2 line 6- 12 and page 10 line 1-8, figure “Network Topology” in page 3, figure “flow details” in page 4, figure “Ring back Tone Basic Call Flow scenario” in page 10); The VoiCD system database has the following (tone information recording means, tone information storing means, and past-record selecting means); it is used for storing subscriber related information, content storing and content related information (relating the calling-terminal specifying information, the called-terminal specifying information and the tone information) (Page 32 section 4.2.5 line 1-2 and section 4.2.6 line 12).

**Olschwang** clearly shows that the user can receive information regarding the tone information; VoiCD Call Data Records CDRs (past-record information storing means) are generated for each successful call for both caller A or subscriber B for transmission ring tones information after receiving the request process (request receiving means) (Page 32, section 4.2.6 lines 20- 23 and page 36 section 6.1.2, line 8-15).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Consider **Claims 3, 4, 6, and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Olschwang (provisional application No. 60/452526)** in view of **Kallas (US Patent # 6,778,653 B1)**.

Consider **Claims 3 and 6**, **Olschwang** shows The VoiCD system has a database (tone information recording means) that used for storing subscriber related information (relating the calling-terminal specifying information, the called-terminal specifying information, and the tone information)

However, **Olschwang** does not specifically disclose that the time (the information relating to the time when the transmitting means has transmitted the tone information) is related to the telephone number of both the receiver and the sender.

In the same field of endeavor, **Kallas** clearly discloses that the contents of the telephony cookie (tone information) may include identifiers of the calling terminal and called terminal, also the date and time when the cookie was created may include in the tone information for the purpose of storing and relating these pieces of information together (abstract).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the time information to the tone information and then store these pieces of information in the (past-record information storing means) as taught by Kallas in Olschwang, in order to store and relate these pieces of information together.

Consider **Claims 4 and 7, Olschwang** clearly shows that the user can receive information about the tone information according to the disclosure request as **applied to claim 1 above**.

However, **Olschwang** does not specifically disclose the time information as part of the data stored.

In the same field of endeavor, **Kallas** clearly discloses that the contents of the telephony cookie (tone information) may include the date and time in addition to the identifiers of the calling terminal and called terminal for the purpose of knowing the time when the cookie was created (abstract).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add and store the time information as taught by Kallas in Olschwang, in order to inform the user about the time that the transmitting means has transmitted the tone if the disclosure request includes the time information, so the past-record information includes the information relating to the time.

### ***Response to Arguments***

8. According to the Applicants request, Examiner accept the provisional double patenting rejection to be held in abeyance until copending application serial No. 11/079101 has been indicated any allowable claim.

9. Applicant's arguments, with regards to amended claim 1, filed 2 February 2008 has been fully considered but they are not persuasive.

10. On page 9 of the Applicant's Response, applicants argue that Olschwang does not disclose a **past-record selecting means** for selecting information corresponding to the calling terminal specifying information and being stored in the past record storing means in accordance with the received disclosure request.

11. The Examiner respectfully disagrees with Applicant's arguments, because Olsechwang discloses that the VoiCD system database is used for storing subscriber related information, Call Data Records CDRs, content storing (tone information) and content related information (calling terminal specifying information). The database storage is accessed by all components for content (tone information) browsing or subscriber details (page 32, section 4.2.5, lines 1-4), knowing that "different content can be chosen for different caller (page 1, section 1, line 10 and line 13-14). Moreover, the content validity in VoiCD platform is maintained by a synchronization application that replicates data and content files (**past-record selecting means**) from the Content Management Server in the Content Management platform (**Past-record storing means**) to the Content Proxy (CPX) in the VoiCD. Then, the (CPX) functions as the proxy for the content from the content Management platform, providing both audio content and content related information to end-users (page 31, section 4.2.4), and that after dedication request process (page 32, section 4.2.6, line 19-20). From the above description, Olsechwang, in deed, discloses the feature of the **past-record selection means** for selecting and providing (transmitting) information corresponding to the calling terminal specifying information.

12. Therefore, in view of the above reasons, Examiner maintains rejections.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amal Zenati whose telephone number is (571)270-1947. The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571- 571-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fan Tsang/

Examiner,

Supervisory Patent Examiner, Art Unit 2614

Amal Zenati

April 26, 2008